

**REMARKS**

Applicants respectfully request the Examiner to reconsider the present application in view of the following remarks.

***Status of the Claims***

Claims 1-5, 7, 9-14 and 16-21 are pending in the present application. A listing of the claims is not needed, as no claims are being added, canceled or amended in the present reply. Also, claim 19 has allowable subject matter (see page 2 of the Office Action).

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw the only rejection and allow the currently pending claims.

***Issues under 35 U.S.C. § 102(b)***

Claims 1, 2, 9-14 and 16-18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Paik *et al.*, *J. Nucl. Med.*, Vol. 24, pp. 1158-1163 (1983) (see pages 2-4 of the Office Action). Applicants respectfully traverse and reconsideration is based on the following remarks.

As recited in instantly pending claim 1, the present invention is directed to a process for producing an amide compound, which comprises reacting a compound having an amino group with a polyaminopolycarboxylic acid anhydride in the presence of the polyaminopolycarboxylic acid.

Not all instantly claimed features are disclosed in the Paik *et al.* reference. In the Office Action, the Examiner states that the cited Paik *et al.* reference teaches the instantly claimed method of amide formation. But Applicants note that a polyaminopolycarboxylic acid is not even disclosed in Paik *et al.*

The Paik *et al.* reference discloses a DTPA anhydride molecule having two anhydride moieties, and an acetic acid residue shows absorption bands which are characteristic of the anhydride carbonyl groups and carboxylate. However, Paik *et al.* do not teach that there is DTPA which has five free acetic acid residues. In other words, the requirements of the instantly claimed process are not fulfilled by the presence of a single acetic acid residue on a single DTPA anhydride molecular since the claimed process is conducted in the presence of a **polyaminopolycarboxylic acid**.

Instead, Paik *et al.* disclose that due to hydrolysis of the anhydride, the reaction reduced the pH of the buffer solution (see pp. 1159+). This merely teaches that the desired acylation of one anhydride group resulted in formation of an acetic acid residue but it does not mention that the **polyaminopolycarboxylic acid** *per se* was present or added to the reaction.

Therefore, the claimed **polyaminopolycarboxylic acid** was not added to the Paik *et al.* reaction, and it cannot be said that the reaction as disclosed in Paik *et al.* was conducted in the presence of the polyaminopolycarboxylic acid. Thus, because “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” the cited Paik *et al.* reference cannot be a basis for a rejection under § 102(b). See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as

instantly claimed, the rejection in view of Paik *et al.* is overcome. Reconsideration and withdrawal are respectfully requested.

In addition, the instantly claimed process shows a superior results as compared to the comparative example of the present specification where the polyaminopolycarboxylic acid was not used in the reaction. Applicants understand that the instant rejection is cited under 35 U.S.C. § 102. Still, evidence of unexpected results is in the present specification and it is improper to not consider such evidence of patentability for the present invention. *See In re Soni*, 54 F.3d 746, 34 USPQ2d 1684 (Fed. Cir. 1995) (error not to consider evidence in the specification); M.P.E.P. § 2144.08(II)(B).

Reconsideration and withdrawal of this rejection are respectfully requested.

### **Conclusion**

In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 09/971,929

Docket No.: 2185-0577P

Art Unit 1654

Reply to Office Action of March 30, 3007

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: JUN 28 2007

Respectfully submitted

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